

PATENT

Atty. Dkt. No. ATT 2003-0266

REMARKS

In view of the following discussion, the Applicants submit that none of the claims now pending in the application are directed to non-statutory subject matter or anticipated under the provisions of 35 U.S.C. §§ 101, 102. Thus, the Applicants believe that all of these claims are now in allowable form. Allowance is respectfully solicited.

I. REJECTION OF CLAIMS 42-44 UNDER 35 U.S.C. § 101

The Examiner rejected claims 42-44 as being directed to non-statutory subject matter under 35 U.S.C. §101. Claim 42 is amended as suggest by the Examiner and now reads as follows: "A computer-readable medium encoded with computer executable instructions that when executed cause a computer system to perform call connection services between user devices using decomposed border elements (BEs)..." As such, Applicants respectfully request that the rejection of claims 42-44 under 35 U.S.C. §101 be withdrawn.

II. REJECTION OF CLAIMS 1-44 UNDER 35 U.S.C. § 102(e)

The Examiner rejected claims 1-44 as being anticipated under 35 U.S.C. § 102(e) by Klaghofer et al. (U.S. Patent App. Pub. No. 2004/0249963, published on December 9, 2004, hereinafter referred to as "Klaghofer"). The Applicants respectfully traverse the rejection.

Klaghofer is not a proper reference under 35 U.S.C. §102(e). Klaghofer was published on December 9, 2004 and is a US national stage application of International Application No. PCT/DE02/03345 filed September 9, 2002. MPEP 706.02(f)(1)(I)(C) instructs:

(C) If the potential reference resulted from, or claimed the benefit of, an international application, the following must be determined:

(1) If the international application meets the following three conditions:

- (a) an international filing date on or after November 29, 2000;
- (b) designated the United States; and
- (c) published under PCT Article 21(2) In English.

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then the international filing date is a U.S. filing date for prior art purposes under 35 U.S.C. 102(e)...

(2) If the international application was filed on or after November 29, 2000, but did not designate the United States **or was not published in English** under PCT Article 21(2), do not treat the international filing date as a U.S. filing date for prior art purposes. In this situation, do not apply the reference as of its international filing date, its date of completion of the 35 U.S.C. 371(c)(1), (2) and (4) requirements, or any earlier filing date to which such an international application claims benefit or priority. The reference may be applied under 35 U.S.C. 102(a) or (b) as of its publication date, or 35 U.S.C. 102(e) as of any later U.S. filing date of an application that properly claimed the benefit of the international application (if applicable).

The international application was published in German, not in English as required for the reference in order to get the benefit of treating its international filing date as a U.S. filing date for prior art purposes. Therefore, the Klaghofer reference may only be applied under 35 U.S.C. §102(a) or (b) as of its publication date of December 9, 2004. However, Applicants' filing date of March 1, 2004 (and having a provisional application filing date of October 16, 2003) predates the Klaghofer's publication date. Therefore, the Klaghofer US patent application publication is not a valid §102(a) or (b) reference. As such, Applicants respectfully request that the rejection of claims 1-44 be withdrawn.

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CONCLUSION


Thus, the Applicants submit that all of these claims now fully satisfy the requirements of 35 U.S.C. §§ 101, 102. Consequently, the Applicants believe that all these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring the issuance of a final action in any of the claims now pending in the application, it is requested that the Examiner telephone Mr. Kin-Wah Tong, Esq. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully Submitted,

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